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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,445	09/25/2006	Yu Sing Hooi	18202.0002U1	7585
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Ballard Spahr LLP			KIDWELL, MICHELE M	
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			05/13/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/582,445	HOOI, YU SING	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michele Kidwell	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 February 2011.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8, 10, 12-15, 19-23, 27 and 28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8, 10, 12-15, 19-23, 27 and 28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/3/11</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2011 has been entered.

### ***Claim Language Interpretation***

4. The claim terminology is interpreted in light of the definitions on page 4, line 25-page 5, line 1 (It is noted that such does not require wearing entirely inside or outside) and page 8, lines 18-20. Any other claim language not specifically defined has been interpreted in view of the usual and common meaning of such, e.g. the dictionary definition.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3, 7-8, 10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd EP '039 in view of Wilson III, '779.

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and '039 at the Figures, esp. 1-4B, page 27, line 8-page 31, last line, page 4, lines 3-11, page 15, lines 16-27, page 10, lines 15-20, the paragraph bridging pages 14-15, page 15, first full paragraph, page 16, lines 1-17, page 17, lines 1-6 and 14-22, page 18, line 1-page 19, line 14, page 20, line 1-page 21, line 9, and page 22, line 19-page 24, last line, i.e. '039 teaches a sanitary product for insertion into a human vagina which includes an internally worn absorbent plug, e.g., at least a portion of 11, and an externally worn absorbent pad, e.g. 6, joined to one another by a sheath 2, 3 that opens through the pad, see, e.g., Figures, esp. 2A and/or page 21, lines 5-9, such that a wearer's finger can be received in the sheath to assist insertion, see, e.g., page 15, lines 1-7 and 11-15 or page 29, lines 13-16. Claim 1 now also requires the sheath be elastic in only a circumferential direction which allows for radial expansion. While '039 at, e.g., the paragraph bridging pages 14-15, the first full paragraph on page 15, page 16, lines 8-10 and page 17, lines 13-17 teaches the sheath of various flexible, e.g., resilient, knit or elastic materials, and capable of expansion diametrically/circumferentially/in a radial direction to receive a finger, i.e. a body part, for digital insertion of the product into the vagina, it does not explicitly disclose the sheath is elastic in only a circumferential direction, i.e. is capable of expansion and retraction in only the circumferential direction. However, see '779 at the abstract, the Figures, col. 1, lines 8-13, 43-46, col. 5, lines 10-19, the Summary of the Invention section, col. 7, lines 38-col. 8, line 3, col. 10, lines 20-32, col. 12, lines 28-43 the paragraph bridging cols. 14-15, the claims, esp. note the preambles, i.e. teaches not only a sheath of various

flexible, e.g., resilient, knit or elastic, materials which is capable of expansion diametrically/circumferentially/in a radial direction to receive a body part, but also which is elastic in only a circumferential direction, i.e. is capable of expansion and retraction in only the circumferential direction, in order to enhance retention. Therefore, to make the sheath capable of expansion diametrically/circumferentially/in a radial direction to receive a finger, i.e. a body part, of '039 a sheath elastic in only a circumferential direction which allows for radial expansion instead, if not already, would either be obvious, see *In re Siebentritt*, 54 CCPA 1083, i.e. two equivalents are interchangeable for the desired function, express suggestion of desirability not needed to render such substitution obvious, i.e. here the equivalents are interchangeable for the desired function of providing expansion diametrically/circumferentially/in a radial direction to receive a body part, i.e. finger, and/or would be obvious to one of ordinary skill in the art in view of the teachings of '779 due to the recognition that such would not only provide a sheath capable of expansion diametrically/circumferentially/in a radial direction to receive a finger but also provide retention thereon which would enhance the efficacy of digital insertion and the desire of such expansion and insertion by '039.

Claim 2: See, e.g., page 17, lines 1-6 and page 19, lines 1-11, i.e. the sheath is liquid impermeable in a direction from the outside of the sheath to the inside of the sheath.

Claim 3: See discussion of claims 1-2, i.e. the sheath comprises tube of liquid impermeable material.

Claim 7: See page 20, lines 7-8 and page 24, lines 12-15, i.e. the sheath comprises a tube of absorbent material.

Claim 8: See overlapping tubular portions of 12, in Figures 1-1A, 2-2A, 3-3A, 4-4B, page 17, lines 1-6, page 18, lines 12-17, page 20, lines 3-8, page 24, last paragraph, i.e. the sheath comprises a tube of liquid impermeable material inside a tube of absorbent material.

Claim 10: See Figure 2B adjacent the arrow from 2 or page 24, last paragraph, i.e. the sheath has a smaller diameter than that of the plug.

Claim 12: See Figure 1B and page 15, lines 16-27, i.e. the sheath extends for substantially 2.5 cm between an end of the plug and a surface of the pad closest to the plug with “sufficient specificity”, see MPEP 2131.03.

Claims 13-14: See Figures, i.e. the product further comprises a cord 7 attached to the plug to assist removal of the plug from the vagina which cord extends along the inside of the sheath.

7. Claims 1, 3-6 and 27 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaysersberg '405 in view of Wilson III, '779

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and '405 at the Figures, esp. 3-4 and 6, the English abstract, see the full English translation, esp. the translation at page 16, second full paragraph, page 10, first full paragraph, page 16, third full paragraph, page 14, second full paragraph and the paragraph bridging pages 14, i.e. '405 teaches a sanitary product for insertion into a human vagina which includes an internally worn absorbent plug, e.g., at least a portion

of 44, 444, and an externally worn absorbent pad, e.g. 2, joined to one another by a sheath 66 that opens through the pad, see, e.g., Figures, such that a wearer's finger can be received in the sheath to assist insertion, see, e.g., the second full paragraph on page 16. Claim 1 now also requires the sheath be elastic in only a circumferential direction which allows for radial expansion. While '405 at, e.g., page 13, second and third full paragraphs and the paragraph bridging pages 13-14 teaches the sheath includes an elastic, deformable or equivalent means capable of receiving a finger, i.e. a body part, for digital insertion of the product into the vagina, it does not explicitly disclose the sheath is elastic in only a circumferential direction, i.e. is capable of expansion and retraction in only the circumferential direction. However, see '779 at the abstract, the Figures, col. 1, lines 8-13 and 43-46, col. 5, lines 10-19, the Summary of the Invention section, col. 7, lines 38-col. 8, line 3, col. 10, lines 20-32, col. 12, lines 28-43, the paragraph bridging cols. 14-15, the claims, esp. note the preambles, i.e. teaches not only a sheath which has an elastic, deformable or equivalent means capable of receiving a body part but such means being elastic in only a circumferential direction, i.e. capable of expansion and retraction in only the circumferential direction, in order to enhance retention. Therefore to make the elastic, deformable or equivalent means of '405 an elastic/deformable structure as taught by '779, if not already, would either be obvious, see *In re Siebentritt*, 54 CCPA 1083, i.e. two equivalents are interchangeable for the desired function, express suggestion of desirability not needed to render such substitution obvious, i.e. here the equivalents are interchangeable for the desired function of providing deformable/elastic means to receive a body part, i.e. finger, and/or

would be obvious to one of ordinary skill in the art in view of the teachings of '779 due to the recognition that such would not only provide a sheath/means thereof capable of expansion diametrically/circumferentially/in a radial direction to receive a finger but also providing retention thereon which would enhance the efficacy of digital insertion and the desire of such expansion and insertion by '405.

Claim 3: See cited portions in discussion of claim 1, i.e. the sheath 66 comprises a tube of liquid impermeable material.

Claims 4-5: See cited portions in discussion of claim 1, i.e. the pad 2 comprises an absorbent layer 7 and a liquid impermeable backing sheet 99 and the backing sheet is integral with the liquid impermeable material of the sheath, see Figure 3.

Claim 6: The sheath passes liquid along its length from the plug to the pad, see English abstract.

Claim 27: The pad is configured to be wearable only externally to the vagina of the wearer, see figure 1 of Kaysersberg.

Claim 28: The plug is connected to one end of the sheath and the pad is connected to the other end of the sheath, see figures 2 – 3 of Kaysersberg.

8. Claims 15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable Lloyd EP '039 and Wilson III, '779 as applied to claim 1 supra, and further in view of Phelps '234, and Denkinger '372.

Claims 15 and 19-20: See the paragraph bridging pages 14-15 and MPEP 2131.03, i.e. the diameter of the plug is 2 cm or less, 1.5 cm or less or 1.5 cm, respectively, with "sufficient specificity". Note also page 12, lines 7-9 of the instant

specification. These claims further require the plug be substantially 4 cm in length or less, substantially 3.5 cm in length or less or substantially 3.5 cm in length, respectively. While '039 suggests such lengths, e.g. see page 15, lines 24-27 and the Figures, '039 does not explicitly teach such. However, note page 12, lines 7-11 of the instant specification, as well as '234 at col. 2, lines 55-58 and '372 at col. 1, lines 64-65 and col. 3, lines 12-15, i.e. the prior art desires the same properties/combination of properties as the instant application, i.e. a portion which is absorbent and sized for wear internally in the vagina as well as length/size being a result effective variable or specific sizes within the claimed ranges. Note also MPEP 2141.05. Therefore, even if the prior art does not include the exact length, the general conditions of the claim are disclosed thereby and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, *In re Aller*, 105 USPQ 233 (CCPA 1955).

9. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over are rejected under 35 U.S.C. 103(a) over Kaysersberg '405 and Wilson III, '779 as applied to claim 1 supra, and further in view of Ohba PCT'611 and Denninger '372.

Claim 21: This claim requires an external portion, i.e. pad, have the shape of a flat ellipse with one end wider than the other. While page 11, lines 25-26 of '405 teach the external absorbent portion may be rectangular, oblong, sandglass or other shape it does not teach the claimed specific shape. However, see '611 at page 6, lines 10-13 and Figures 3-7 of '372, esp. Figure 7, i.e. interchangeability of shapes of external absorbent portions similar to '405 for those claimed, i.e. ellipsis with different sized

ends. To make the shape of '405 the claimed shape instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by '611 and '372.

Claims 22-23: These claims require the pad be substantially 6.5cm long and 5.5cm wide or substantially 0.5cm thick, respectively, which '405 does not teach. However, see '611 at page 6, lines 18-30 and '372 at col. 3, lines 12-18 as well as page 13, lines 7-13 of the instant specification, i.e. the prior art desires the same properties/combination of properties as the instant application, i.e. a portion which is absorbent and sized for comfortable wear externally as well as length/width/caliper/size being result effective variables and/or specific sizes within the claimed ranges. Note also MPEP 2141.05. Therefore, at the very least the general conditions of the claim are disclosed thereby and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, *In re Aller*, 105 USPQ 233 (CCPA 1955).

### ***Double Patenting***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-8, 10, 12-15, 19-23 and 27 – 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 11/920481. Although the conflicting claims are not identical, they are not patentably distinct from each other. Since there was no administrative delay, the one way *In re Vogel* test applies, i.e. are the claims of the

instant application obvious in view of the other application claims? The answer is yes. Claim 1 of the instant application is broader with regard to some aspects and narrower with regard to other aspects of the claims of the other application. With regard to the broader aspects (e.g. the instant application does not require a line of weakness, see claim 1 in the other application), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claim anticipates the application claim. See *In re Goodman*, *supra*. With regard to the narrower aspects (e.g. the instant application claim 1 requires a sheath which is elastic in only a circumferential direction which allows for radial expansion), note claims, e.g., 18 and 17 in the other application as originally filed and as now amended. To make a sheath as claimed in the other application, e.g., claim 18, which is capable of receiving a finger also resiliently expandable in a radial direction as claimed in claim 17 of the other application would be obvious to one of ordinary skill in the art in view of the recognition that such provides the sheath with the capability of receiving a finger as desired.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

12. Applicant's remarks have been carefully considered but are deemed either moot in that the issue discussed has not been reraised or not persuasive for the

reasons discussed *supra*. Specifically, Applicants arguments with regard to each singular reference is not commensurate with the grounds of rejection based upon a combination of references, not any one singular reference. Also, Applicant's remarks with regard to the prior art references is narrower than the claim language and/or the teachings of the prior art. For example, the claims do not require the pad be worn entirely outwardly of the vaginal orifice, see CLI *supra* and numeral 6 of Lloyd denotes an absorbent element which is at least in part worn outwardly of the orifice, e.g. page 27, lines 24-26 only disclose the opening of the guide worn internally. See also Figures. For another example, Applicant's remarks on page 4, first two full paragraphs, with respect to Wilson are narrower than the claim language, i.e. "elastic in only a circumferential direction, which allows for radial expansion" (note Wilson teaches "radially and circumferentially extensible" as set forth by Applicant in this response also note Applicant's remarks in the first paragraph of page 8 of the 5-20-10 response), and/or the teachings of Wilson, see, e.g., the cited portions again, e.g., col. 10, lines 27-32 and the paragraph bridging cols. 14-15, teach the claimed direction of elasticity only. Applicant is requested to point out where it is disclosed that such is elastic in a direction other than claimed. As a final example, Applicant's remarks on page 4 with regard to Kaysersberg are also narrower than the claim language, i.e. "joined" includes either direct or indirect joining and/or the claim does not require joining of the plug and pad only by the sheath, and/or the teachings of Kayserberg, see the entire reference, esp., e.g., the cited portions and Figures, i.e. at the very least the sheath, e.g. 66, 666, indirectly joins the pad, e.g., pad portion 99, 999, to the plug, e.g., 44, 444.

Applicant's remarks on page 5 regarding the double patenting issues have been noted.

The applicant's arguments with respect to newly presented claims 27 – 28 are not considered persuasive as the claimed limitations are taught by Kaysersberg in the figures as set forth in the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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